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10/705,344

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36261

5170

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EXAMINER

GEHMAN, BRYON P

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/705,344
Filing Date: November 10, 2003
Appellant(s): SAHO, HIDEHIRO

MAILED
JUN 01 2007
Group 3700

Deborah L. Corpus
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed February 7, 2007 appealing from the
Office action mailed June 9, 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,389,672	ISHII et al	5-2002
3,431,548	BUSLER	3-1969

Art Unit: 3728

07165260

SUMITOMO BAKELITE CO 6-1995

LTD.

(9) Grounds of Rejection

The following grounds of rejection are applicable to the appealed claims:

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 7 and 10-11 were rejected under 35 U.S.C. 103(a) as being unpatentable over Ishii et al. (6,389,672) in view of Busler (3,431,548). Ishii et al. disclose an electronic part supplying tape comprising multiple tape members each having a first connecting portion (one end of a series of elements 10), and a second connecting portion (another end of a series of elements 10), an alignment means (interengaging portions of the connecting portions 8a and 8b), and a holding means (interengaging portions of the connecting portions). Busler discloses a first connecting portion (at 44), and a second connecting portion (at 46), an alignment means (43, 44 and 48, interengaging portions of the connecting portions align the first and second members in longitudinal, width and thickness directions of the tape members), and a holding means (44 and 46), wherein the first connecting portion comprises a locking

member (43) and the second connecting portion comprises a locked member (44). To modify the tape of Ishii et al. employing the connecting structure of Busler would have been an obvious substitution of connecting, aligning and holding structures already known in the art, the advantages of connecting and aligning being described by Busler. To provide the connecting portions as integral attached members as opposed to unitary members of the tape would have been an obvious modification of the structural combination, as it has been long held to provide a unitary structure in discrete elements where the elements work the same or similarly has been held to be obvious modification of an existing structure to one of ordinary skill in the art.

As to claim 7, a reel (3 or 4) is disclosed by Ishii et al. with the tape wound around it.

As to claims 10 and 11, Busler discloses the locking member (43) comprising a flat plate portion with an upstanding engaging member, the locked member (44) comprising a stepped plate portion with an engaging hole (at 44), the plate portions being stepped so as to not produce a stepped difference when the members are engaged.

Claims 12 and 13 were rejected under 35 U.S.C. 103(a) as being unpatentable over EP 07165260 in view of Busler (3,431,548). EP 07165260 discloses an electronic part supplying tape comprising multiple tape members each having a first connecting portion (one end of a described tape piece), and a second connecting portion (the other end of the described tape piece), an alignment means (portions K and K), and a holding

Art Unit: 3728

means (portions received in portions K and K), the tape members each having a plurality of recessed portions (cavity parts) formed at a constant pitch and a plurality of feed holes (6) formed at a constant pitch for feeding the tape member, with the feed holes extending the entire length of the tape member. Busler discloses a first connecting portion (at 44), and a second connecting portion (at 46), an alignment means (43, 44 and 48, interengaging portions of the connecting portions align the first and second members in longitudinal, width and thickness directions of the tape members), and a holding means (44 and 46), wherein the first connecting portion comprises a locking member (43) and the second connecting portion comprises a locked member (44). To modify the tape member of EP 07165260 employing the connecting structure of Busler would have been an obvious substitution of connecting, aligning and holding structures already known in the art, the advantages of connecting and aligning being described by Busler. To provide the connecting portions as integral attached members as opposed to unitary members of the tape would have been an obvious modification of the structural combination, as it has been long held to provide a unitary structure in discrete elements where the elements work the same or similarly has been held to be obvious modification of an existing structure to one of ordinary skill in the art. To have the feed holes extend the entire length of the tape member would provide a feed hole in a positional relationship to a feed hole of an adjacent tape member.

(10) Response to Argument

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the base references to Ishii et al. and EP 07165260 each disclose an electronic part supplying tape comprising opposite connecting portions (one end of a series of elements 10, and a second end of the series of elements 10 in Ishii et al and one end of a described tape piece and the other end of the described tape piece in EP 07165260), an alignment means (interengaging portions of the connecting portions 8a and 8b in Ishii et al. and portions K in EP 07165260) and a holding means (interengaging portions of the connecting portions in Ishii et al. and portions received in portions K and K in EP 07165260) for positioning the connecting portions, the difference being that appellants claim the alignment means positioning the connecting portions in a longitudinal direction, a width direction and a thickness direction, i.e. in three dimensions. The structure of Busler, employed to join a first tape member to a second tape member, provides the alignment means that is similar to that disclosed by appellants (see Figures 5A and 5B of the instant application) that provides alignment in three dimensions. This

Art Unit: 3728

advantage was disclosed by Busler when joining two tape members, and the fact that it was known to provide an electronic part supplying tape by joining at least two tape members as provided by Ishii et al. and EP 07165260, to employ an alignment means such as disclosed by Busler to derive the expected alignment function for analogous part carrying tape members is maintained to have been obvious to one of ordinary skill in the art.

For the above reasons, it is believed that the rejections should be sustained.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

Respectfully submitted,

Bryon P. Gehman



Conferees:


Mickey Yu
Tom Hughes